

REMARKS

The Claims have been amended by cancelling Claims 2 and 7, and by amending Claims 1, 3-6, and 8-18.

Claims 1, 3-6, and 8-18 are pending in this application.

The only substantive amendment presented in the present paper is the amendment to Claim 1. Dependent Claims 2 and 7 have been canceled as being redundant in view of the amendments to independent Claim 1. All other amendments are being made to conform the dependent Claims to independent Claim 1 as amended. No other substantive changes are intended in any of the dependent Claims, beyond such conforming changes.

Independent Claim 1 has been amended in two aspects: **(1)** The limitations of former dependent Claim 7 have been incorporated into independent Claim 1 (roughly, the middle third of Claim 1 as now written). **(2)** A set of alternative limitations (d) through (f) has been added.

Basis for the first aspect of the amendment to Claim 1 is found, for example, in Claim 7 as originally filed. (Note that a minor typographical error in original Claim 7 was corrected in the course of amending Claim 1: "wherein one or two of R7, R8, R9, R10, and R11 are ~~hydrogen~~ or such a carboranyl group")

Basis for the second aspect of the amendment to Claim 1, the new alternative limitations, is found, for example, in the following locations: alternative limitation **(d)**: paragraphs [0014] and [0027] of the specification, and Claim 3 as originally filed; alternative limitation **(e)**: paragraph [0025] of the specification, and Claims 12 and 13 as originally filed; and alternative limitation **(f)**: paragraphs [0020], [0021], [0025] of the specification, and Claims 5 and 11 as originally filed.

A \$510 fee for a three-month extension of time is being paid online as a small entity, to extend the time for response from March 8, 2007 to June 8, 2007. If any additional extension of time is required, please consider this paper a petition for the total extension of time required. If this amount is incorrect, please refer to the Deposit Account Authorization previously filed with this application.

ARGUMENTS

The § 102 Rejections

Claims 1, 3-6, and 8-18 were rejected under 35 U.S.C. § 102(e) or § 102(b) as being anticipated by either of two cited references.

Claim 1 is the sole independent Claim. If an independent Claim is novel and nonobvious, it logically follows that the dependent Claims are necessarily novel and nonobvious as well. See M.P.E.P. § 2143.03, first paragraph. Therefore, the following discussions of the § 102 rejections focus on independent Claim 1. Applicant reserves the right to present alternative arguments concerning the dependent Claims at a later date.

The § 102 (e) Rejection

Claims 1, 3-6, and 8-18 were rejected under 35 U.S.C. § 102(e) as being anticipated by Vicente *et al.*, WO 01/85736.

The Office expressly based this ground of rejection on anticipation by the doctrine of inherency: "It would be inherent that the carboranylporphyrin compounds taught by Vicente *et al* would selectively bind to molecules in tumor cells . . . since the carboranyl compounds taught by Vicente *et al* have the exact same chemical structure as the compounds recited in the instant claims, and therefore, one of ordinary skill in the art would expect the compounds taught by Vicente *et al* to chemically behave in the same manner as the instantly claimed compounds." December 8, 2006 Office Action, pages 2-3.

It is respectfully submitted that the present amendment to Claim 1 overcomes any contention that the processes described in WO 01/85736 anticipate by the doctrine of inherency. As stated in M.P.E.P. § 2112, part IV (citations omitted):

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. . . . " To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" . . .

“In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.”

The combined limitations of amended Claim 1 are taught nowhere in WO 01/85736, and are not a necessary or inherent consequence of anything that is taught by WO 01/85736.

It is respectfully submitted that this ground of rejection has been overcome.

The § 102 (b) Rejection

Claims 1, and 3-6 were rejected under 35 U.S.C. § 102(b) as being anticipated by Miura *et al.*, U.S. Patent 4,959,356.

Former Claim 7, however, was not found to be anticipated by Miura '356.

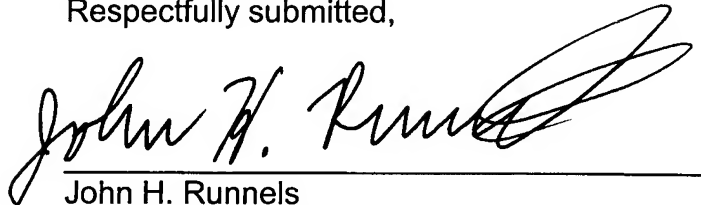
The limitations of former Claim 7 have now been incorporated into independent Claim 1. Because former Claim 7 was not anticipated by Miura '356, it follows that amended Claim 1 is likewise not anticipated by Miura '356.

it is respectfully submitted that this ground of rejection has been overcome.

Conclusion

Allowance of Claims 1, 3-6, and 8-18 at an early date is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "John H. Runnels", is written over a horizontal line.

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